IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	09/693,321	Examiner:	Singh, Rachna
Filed:	October 19, 2000	Group/Art Unit:	2176
Inventors:		Atty. Dkt. No:	5181-57700
	Mohamed M. Abdelaziz, et al.		
Title:	DYNAMIC DISPLAYS IN A DISTRIBUTED COMPUTING ENVIRONMENT		

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT MAILED DECEMBER 19, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted in response to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed December 19, 2006.

In the Notice of Non-Compliant Amendment (37 CFR 1.121) the Examiner asserts that the amendment filed by Applicants on September 29, 2006 is not drawn to the new rejection presented in the Examiner's Answer of July 26, 2006. In particular, the Examiner asserts that the new ground of rejection was to address the interpretation of the term "service". The Examiner asserts that Applicants' amendment is not drawn to better define the term service. For at least the following reasons, Applicants assert that the

Notice of Non-Compliant Amendment under 37 CFR 1.121 is improper and that Applicants' previous amendment is in complete compliance with all relevant rules.

The Examiner has declared Applicants' amendment to be non-compliant under 37 CFR 1.121 as not drawn to the new rejection presented in the Examiner's Answer. **However, there is no requirement in 37 CFR 1.121 pertaining to amendments filed in response to a new ground on rejection in an Examiner's Answer after appeal.** Thus, the Notice of Non-Compliant Amendment under 37 CFR 1.121 is improper and should be withdrawn.

Applicants note that 37 CFR 41.39(b)(1) does address amendments filed in response to a new ground on rejection in an Examiner's Answer after appeal. However, contrary to the Examiner's assertion, this Rule does require that such an amendment be "drawn" to the new ground of rejection. Instead, the Rule only requires that the amendment be "relevant" to the new ground of rejections. As explained in more detail below, Applicants' amendment is certainly *relevant* to the new ground of rejection and thus is fully compliant with 37 CFR 41.39(b)(1).

In regard to the independent claims, the Examiner's original rejection on appeal was based on the standard of anticipation under 35 USC § 102(e). The Examiner's new ground of rejection is based on the obviousness standard under 35 USC § 103(a). Although the Examiner's *reason* for the new amendment may have been to address the term "service", the *effect* of the new ground of rejections was to change the rejection from being based on the anticipation standard to being based on the obviousness standard. Thus, by making the new ground of rejection after appeal, the Examiner opened the door for the reference to be considered on appeal under the obviousness standard and not just the anticipation standard. The fact that the Examiner's reason for the new ground of rejection was to address the term "service" does not change the fact that the Examiner applied an entirely new standard of rejection under § 103(a) in the new ground of rejection after appeal. When Applicants' re-examined the rejection under the newly asserted obviousness standard, Applicants' decided that it would be prudent to

amend the claims to advance prosecution. Thus, Applicants' amendment was directly relevant to the Examiner's new ground of rejection based on the obviousness standard.

The purpose of allowing applicants to reopen prosecution and amend the claims in response to a new ground of rejection in an Examiner's Answer is that it would not be fair to allow the examiner to change the basis for rejection at such a late date (after appeal) and not allow applicants a chance to amend the claims in response. Here, since the Examiner has changed the standard for rejection from the anticipation standard to the obviousness standard, Applicants must be given the opportunity to amend the claims in response.

Furthermore, contrary to the Examiner assertion, Applicants' amendment does indeed serve to further define the term "service". For example, claim 1 was amended to further define the service as executing on a device separate from the process that accesses the schema and presents the results. Thus, the amendment is certainly relevant to (and drawn to) clarifying the role and context of the "service" in Applicants' invention.

In light of the above remarks, Applicants assert that the amendment of September 29, 2006 is in full compliance with all relevant rules. Accordingly, the amendment must be entered and prosecution re-opened.